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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,235	03/13/2001	Douglas R. Deming	DD-1	2129
7590	09/08/2004		EXAMINER GECKIL, MEHMET B	
Michael I. Kroll 171 Stillwell Lane Syosset, NY 11791			ART UNIT	PAPER NUMBER
			2142	
DATE MAILED: 09/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/805,235	Applicant(s) DEMING, DOUGLAS R.	
	Examiner Mehmet B. Geckil	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03132001</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2142

1. Claims 1-20 are presented for examination. Applicant elected claims 1-14 for prosecution in response to the restriction requirement.
2. Applicant's election of claims 1-14 in the reply filed on 7/22/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, claims 15-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. The restriction requirement is made FINAL.
3. This application contains claims 15-20 drawn to an invention nonelected without traverse in the reply of 7/22/04. A complete reply to the final rejection must include cancellation of nonelected claims.
4. The abstract of the disclosure is objected to because it is not one paragraph. Correction is required. See MPEP § 608.01(b).
5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-14 recite a program. A program not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. (See MPEP section 2106, Seventh Edition, Revision No. 1 dated February 2000, at page 2100-10 and 2100-11.)

7. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention and failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure.

Applicant did not teach the details of the TCP/IP handler as claimed in claims 5 and 10 as well as API as claimed in claim 11. It would take undue experimentation for one of ordinary skill in the art to determine the details of the TCP/IP handler and the API.

The examiner contends that it would require undue experimentation for one of ordinary skill in the networking art to make and use the claimed invention for the reasons set forth hereinabove. Applicant is reminded that no new matter is allowed in the amendment to the specification under 35 U.S.C. 132 and 37 CFR 1.118(a).

8. Claims 1-14 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Procomm Plus.

11. Procomm Plus was a very well known and widely used modem communications program which dated back to 1989-1991 well before the applicant's claim to such features. Examiner personally used the Procomm Plus and is quite familiar with it. Procomm Plus, had a record mode for recording the remote computer's prompts and the user's responses, e.g. like a log-on procedure to create a source script file for compiling and using to automate that procedure by playing back the script (e.g., see Procomm Plus manual page 122.) Applicant's claimed invention is an obvious variation of Procomm Plus' recording mode and playing back the script because applicant's claimed invention also records remote computer's prompts and user's responses to it and playback. It would have been obvious to one of ordinary skill in the networking art at the time of the invention that the claimed invention differed from the teachings of Procomm Plus only by a degree, e.g., being in the modem communication environment versus being in the web communication environment (HTTP is the web communication means.) This is no more than a technician's skill to adapt an inventive concept from one technology environment to another technology environment. Inventive concept is the same. Applicant did not invent a new inventive concept. The inventive concept was taught by Procomm Plus, i.e., capturing the

commands (via a script) used on log-on and the responses from the remote computer (server) and then replaying the captured commands in the script to automate the log-on procedure. Applicant described the same concept of recording and playback in the specification, e.g., see pages 20-21, and 33-34 albeit in the web environment. But this does not make it a new invention. It is no more than an adaptation of the well known old techniques to the new environment.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehmet Geckil whose telephone number is (703) 305-9676. The examiner can normally be reached on Monday through Friday from 6:30 A.M. to 3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Jack Harvey, can be reached on (703) 305-9705. The fax phone numbers for the organization where this application or proceeding is assigned are listed hereinbelow.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700. Customer service number is (703) 306-5631.

Any response to this action should be mailed to:

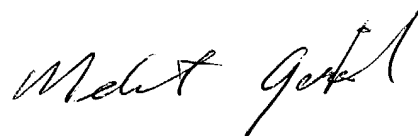
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

9/3/04



MEHMET B. GECKIL
PRIMARY EXAMINER